

REMARKS

Claim Objections

The Examiner has objected to claims 9 and 23 due to a typographical error. Applicants have corrected the error in claim 9 and have cancelled claim 23.

The Examiner has objected to claim 23 as being of improper dependent form for failing to further limit the subject matter of the previous claim. Applicant has cancelled claim 23.

The Examiner has objected to claim 24 as being of improper dependent form for failing to further limit the subject matter of the previous claim. The Examiner has requested that the claim be rewritten in proper dependent form or in independent form. Claim 24 is an independent claim. Applicants believe that this claim is in proper form.

Claim Rejections – 35 U.S.C. §112

Applicant has amended claims 1 and 23 to particularly point out and distinctly claim the subject matter which Applicant regards as his invention.

Claim Rejections – 35 U.S.C. §103

The Examiner has rejected claims 1-7 and 10-35 under 35 U.S.C. 103(a) as unpatentable over Wagner et al. U.S. Patent NO. (5,669,559) in view of Prosser et al. U.S. Patent No. (3,687,699). Applicant respectfully traverses this rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references *must teach or suggest all the claim limitations*. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 20 USPQ

1438 (Fed.Cir. 1991); MPEP § 2142. The Examiner bears the initial burden of factually supporting a *prima facie* conclusion of obviousness.

In order for an obviousness rejection to stand, “the prior art references *must teach or suggest all the claim limitations.*” *In re Vaeck*, 20 USPQ 1438 (Fed.Cir. 1991); MPEP § 2142. To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested. *In re Royka*, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 165 USPQ 494; MPEP §2143.03.

The Examiner has rejected claims 1, 10, 11 and 24 stating that Wagner discloses substantially all of the claimed structure with the exception of adding hydrous silicate. The Examiner states that in a closely related art Prosser discloses a process for granulating tacky elastomeric material such as elastomeric polymers by adding a dusting agent such as talc or hydrous silicate. The Examiner then simply states that it would have been obvious to one skilled in the art at the time the invention was made to provide Wagner with a dusting agent such as talc or hydrous silicate for pulverizing polyurethane as taught by Prosser. The Federal Circuit in *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998) stated “this court requires the examiner to show a motivation to combine the references that create the obviousness ... [i]f such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance.”

Wagner describes a mechanical process for pulverizing polyurethane material. The process used is a simple mill process of grinding and/or pulverizing using rollers and sifting out smaller particles while the coarse particles are recirculated through the roller mill. Prosser, on the other hand, specifically describes a process of cutting or shearing action directly in contrast to the crushing or grinding action of impact or attrition mills, which has the effect of granulating the product but does not purport to give a finely-divided or pulverized product (column 2, lines 25-30).

First, there must be some motivation to combine the references. “The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. In addition, the teaching, motivation, or suggestion may be implicit from

the prior art as a whole, rather than expressly stated in the references ... Whether the Board relies on an express or implicit showing, it must provide particular findings related thereto. Broad conclusory statements standing alone are not evidence." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 11313, 1317. In this case, there is no motivation to combine the references. Prosser explicitly teaches away from Wagner by stating that the invention is not meant to give a finely-divided or pulverized product while that is the specific purpose of Wagner. There is no motivation to combine these two references.

Second, if a prior art reference is cited that requires some modification in order to meet the claimed invention and such modification would destroy the purpose or function of the invention disclosed in the reference, one of ordinary skill in the art would not have found a reason to make the claimed modification. See *In re Gorden*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In this case, Prosser's invention specifically states that it does not purport to give a finely-divided or pulverized product. To combine Prosser with Wagner would destroy the purpose or function of Prosser as taught in the 3,687,699 patent. As such, all claim limitations are not taught or suggested, as required to establish a *prima facie* case of obviousness. *In re Wilson*, 165 USPQ 494; MPEP §2143.03.

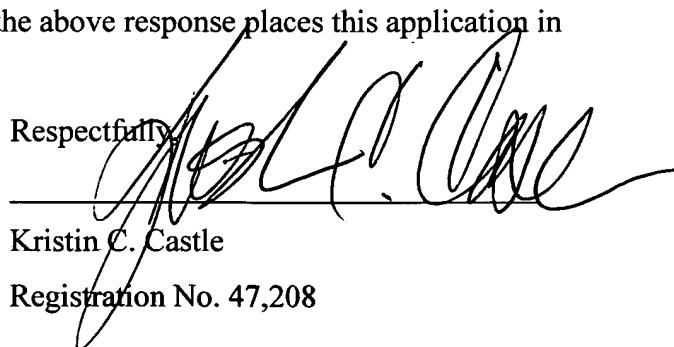
The Examiner has rejected dependent claims 2, 3, 4, 5, 6, 7, 8, 9, 12, 13, 14, 15, 16, 17, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36 and 42. If an independent claim is nonobvious under 35 USC 103, then any claim depending therefrom is nonobvious. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP §2143.03.

The Examiner has also rejected dependent claims 18-22 and 37-41. Applicants have cancelled these claims.

CONCLUSION

Applicant respectfully believes that the above response places this application in condition for allowance.

Respectfully,


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